UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,663	02/23/2004	Andrew J. Vilcauskas JR.	KLR/KAR:8096.0010	2280

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EXAMINER
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ART UNIT	PAPER NUMBER
2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="3">Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td></tr>
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<tr><td>Examiner</td></tr>
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2167</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>20-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>20-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>23 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>20040813</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

The Invention

1.   The claimed invention is drawn to a method of presenting advertisements in a

computer system through the use of popunder windows. Alternative claimed

embodiments are implemented in other media, such as a PDA, telephone, television

and radio.

Priority

2.   The Applicants' claim to domestic priority under 35 U.S.C. § 120 as a divisional

application based upon application 09/866,425, filed 24 May 2001, which claims priority

under 35 U.S.C. § 119(e), to provisional application 60/207,698, filed 26 May 2000, is

acknowledged. Since the subject matter of the parent provisional application

encompasses that of the instant application and claims, a priority date of 26 May 2000 is

hereby established.

Response to Preliminary Amendment

3.   The Applicants' preliminary amendment, filed 10 August 2004, has been

received, entered into the record, and considered.

4.   As a result of the amendment, claims 1-19 have been canceled, and new claims

20-39 have been added. Claims 20-39 are now presented for examination.

Information Disclosure Statement

5.   The Applicants' Information Disclosure Statement, filed 13 August 2004 (a

duplicate of which was received on 13 December 2004), has been received and entered

into the record.

The examiner notes that a number of non-patent references were not included in

the Applicants' submission, nor were they located in the file wrapper of the parent

application. In addition, two patent references' numbers did not correspond to the

inventor name listed on the IDS. These references were not considered.

See attached form PTO-1449.

Double Patenting

6.   Claims 20-39 are provisionally rejected under 35 U.S.C. 101 as claiming the same

invention as that of claims 21-40 of copending Application No. 09/866,425. This is a

provisional double patenting rejection since the conflicting claims have not in fact been

patented.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating
            obviousness or nonobviousness.

9.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

10.   Claims 20-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Landsman et al. (U.S. Patent Application Publication 2003/0004804) in view of **Porn**

Rodeo ("source code of www.pornrodeo.com as of 15 November 1999").

11.   Regarding claim 20, **Landsman et al.** teaches a system for Internet advertising for

use in a media capable of simultaneously maintaining a foreground window and at

least one background window and capable of displaying a first browser in a said

foreground window for selectively browsing the Internet substantially as claimed, said

system comprising:

  a) a script handler that invokes a post-session procedure in said first browser (see

       disclosure that HTML advertising tags are embedded in a web page,

       Abstract; see also Figures 2A and 2B); and

  b) an event handler that receives, from an Internet address, a link to an

       advertisement and loads said advertisement (see paragraphs [0003], [0016],

       [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

Landsman et al. does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see window.open and window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

12.   Regarding claim 30, **Landsman et al.** teaches a post-session advertising method

for use in media capable of simultaneously maintaining a background window and a

foreground window, said method comprising the steps of:

   a) embedding post-session instructions into a first browser, said first browser for

      being displayed in said foreground window (see disclosure that HTML

      advertising tags are embedded in a web page, Abstract; see also Figures 2A

      and 2B);

   b) said post-session instructions receiving, from an Internet address, a link to an

      advertisement (see discussion of a request for, and receipt of, an

      AdDescriptor file, a text file containing a list of file names and

      corresponding URLs at which these files reside, paragraphs [0103] through

      [0107]); and

   c) loading said advertisement (see paragraph [0107]).

   Landsman et al. does not explicitly teach a method wherein said post-session

instructions open a second browser in a background window while said first browser is

simultaneously displayed in said foreground window, and wherein said advertisement

is loaded into said second browser in said background window.

Porn Rodeo, however, teaches a method wherein said post-session procedure

opens a second browser in a background window while said first browser is

simultaneously displayed in said foreground window, and wherein said advertisement

is loaded into said second browser in said background window (see window.open and

window.focus calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to open a browser in the background and load the advertisement directly into

the browser, since this would allow the display of the advertisement to the user (by

moving the browser window to the foreground) without the need to open a new

window, load any required player files, and load and render the advertisement, thus

speeding the display of the advertisement to the user.

13.   Regarding claims 21 and 31, **Porn Rodeo** additionally teaches a system and

method wherein said second browser is opened in response to a load-triggering event

(see window.open call on page 1, lines 16-17, showing that the load-triggering event

was the loading of the porn rodeo web page).

14.   Regarding claims 22 and 32, **Porn Rodeo** additionally teaches a system and

method wherein said load-triggering event comprises at least one of clicking on an off-

site link, entering a new address, refreshing a web site, exiting a web site, and being

redirected to a web site (see window.open call on page 1, lines 16-17, showing that the

load-triggering event was the loading of the porn rodeo web page, analogous to both

refreshing a web site and being redirected to a web site, since both would entail the

loading of the web page).

15.   Regarding claims 23, 24, 33 and 34, **Landsman et al.** additionally teaches a

system and method wherein said script handler delays invocation of said post-session

procedure for a predetermined period of time, and wherein said script handler cancels

invocation of said post-session procedure if a user loads a new web site in said first

browser before said predetermined time period has elapsed (see disclosure of the timer

based frame targeted advertisements, paragraph [0159]).

16.   Regarding claims 25 and 35, **Landsman et al.** additionally teaches a system and

method wherein said second browser is displayed in a foreground window after the

occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

17.   Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and

method including a focus timer that tracks the duration that said second browser is

displayed in said foreground window (see paragraph [0050]).

18.   Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and

method wherein said media comprises one of a computer, a PDA, a cell phone and a

television (see disclosure that the system is executed in a computer, Abstract).

19.   Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and

method wherein said event handler selects and returns one of a plurality of

advertisements maintained at said Internet address (see paragraph [0104]).

20.   Regarding claims 29 and 39, **Porn Rodeo** additionally teaches a system and

method capable of opening a plurality of second browsers, each maintained in a

separate background window, said event handler capable of receiving a link to an

advertisement for each browser and loading a respective said advertisement into each

said second browser while each said second browser remains in its respective said

background window (see window.open and window.focus calls on page 1, lines 15-20,

code that would open an additional background window each time the web page was refreshed).

Response to Arguments

21. Applicant's arguments with respect to claims 20-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Advertisement Banners ("About Us - Advertisement Banners") discloses the fact that the company Advertisement Banners launched the SpecificPOP ad network in January 2000, and that the network specializes in the strategic placement of the Internet's highest performing ad unit, the pop-under.

SpecificPOP ("About SpecificPOP") discloses that SpecificMedia launched the SpecificPOP as network in 2000, and that the network specializes in pop under advertising.

Chuang et al. ("Bankrupcy of Wireless Camera Firm May Hurt California Brothers' Suit") discloses that the Vanderhook brothers launched AdvertisementBanners

in 1999, and that the company focused on pup-under ads, which opens a browser

window underneath your current window.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Luke S. Wassum whose telephone number is 571-272-

4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the

examiner at 571-273-4119. <u>Such communications must be clearly marked as</u>

<u>INFORMAL, DRAFT or UNOFFICIAL.</u>

Customer Service for Tech Center 2100 can be reached during regular business

hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the

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Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
18 August 2006